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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,161	03/19/2004	Mark W. Kimberlin	D-3054	7384
33197	7590	05/18/2005	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			SINGH, SUNIL	
4 VENTURE, SUITE 300			ART UNIT	PAPER NUMBER
IRVINE, CA 92618			3673	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,161

Applicant(s)

KIMBERLIN, MARK W.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-7,9-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22, the preamble of claim 22 does not commensurate with the preamble of the claim from which it depends.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by British document (1475682).

British document '682 discloses a system for stabilizing a surface (see Fig. 1, page 1 line 10) prone to soil erosion, the system comprising: a porous element (10,12) disposed on a surface to be stabilized; and a flowable material (see page 1 lines 30-40, (14), page 2 lines 20-35, page 2 lines 75-80) incorporated within the porous element; the system being made by anchoring (10A) the porous element to the surface and thereafter injecting the flowable material (see page 1 line 84+) into the porous element

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and thereafter allowing the flowable material to set within openings defined within the porous element (see page 1 lines 25-40, page 2 lines 20-35). The porous element is a cellular matting (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30). The porous element comprises a netting material (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30) comprises a netting material. The porous element comprising a reinforced fiber matting (10,12).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6,7,9,10,11,12, 13-15, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over British document (1475682).

British document '682 discloses a system for stabilizing a surface (see Fig. 1, page 1 line 10) prone to soil erosion, the system comprising: a porous element (10,12) disposed on a surface to be stabilized; and a flowable material (see page 1 lines 30-40, (14), page 2 lines 20-35, page 2 lines 75-80) incorporated within the porous element; the system being made by anchoring (10A) the porous element to the surface and thereafter injecting the flowable material (see page 1 line 84+) into the porous element and thereafter allowing the flowable material to set within openings defined within the porous element (see page 1 lines 25-40, page 2 lines 20-35). The porous element is a cellular matting (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30). The

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porous element comprises a netting material (see page 1 lines 20-30, page 1 lines 50-95, page 2 lines 25-30) comprises a netting material. The porous element comprising a reinforced fiber matting (10,12). British document discloses the invention substantially as claimed. However, British document is silent about the flowable material including fibers. The examiner takes official notice that fiber reinforced concrete (cement grout) is well known and old in the art. It would have been considered obvious to one of ordinary skill in the art to modify British document by including fibers in the flowable material in order to reduce plastic shrinkage cracks in the structure.

With regards to claim 22, claim 22 is considered to be a product-by-process claim, and the examiner notes that it has been held that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in a product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) see MPEP 2113.

7. Claims 1-7, 9-15, 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over British document '682 in view of West et al. (US 5459181).

British document '682 discloses the invention substantially as claimed. However, British document lacks a flowable material comprising a mixture of fibers and a polymeric bonding material being applied using conventional seeding apparatus. White et al. teaches flowable material comprising a mixture of fibers, seeds and a polymeric

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bonding material (see abstract) being applied using conventional seeding apparatus (see col. 2 thru col. 5). It would have been considered obvious to one of ordinary skill in the art to modify British document '682 by substituting the flowable material with its corresponding applicator as taught by West et al. for the flowable material and its corresponding applicator disclosed by British document '682 since this allows for planting of seeds which ultimately results in plants becoming established thus further preventing erosion.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 13 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



SS


5/13/05

SUNIL SINGH
PRIMARY PATENT EXAMINER